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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,559	12/14/2001	Tommy Petrogiannis	9680.188USU1	3770
23552 7590 08/13/2007 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER POWERS, WILLIAM S	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/022,559

Applicant(s)

PETROGIANNIS ET AL.

Examiner

William S. Powers

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15, 37, 39, 60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-36, 38, 40-59 and 62-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 5/29/2007 have been fully considered but they are not persuasive.
2. As to Applicant's argument that "the authenticator identification envelope of Romney could not possibly include such information since it is created by the authenticator, a party whose task consists in verifying and authenticating a signature, who is generally not present when this signature is applied to the document," Applicant is directed to the Abstract of Romney which states, "The client digitally signs the electronic document in the presence of the authenticator." Clearly, the authenticator is present for the signing. The signature is authenticated and the signing is authenticated by the authenticator. This information is in the authenticator identification envelope of Romney as well as other data including, but not limited to date, time and place of signing, identification used to authenticate the signer (passport, driver's license, biometric data) and information identifying the authenticator (Romney, fig. 9B). It is clear that Romney supplies the information necessary to reconstruct the signing of an authenticated document and that Romney satisfies that claim limitations associated with a process log for recreating the authenticated signing of a document.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

Art Unit: 2134

(i.e., authenticator identification envelope does not constitute a simple code) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. As to Applicant's argument that Romney does not teach embedding of such a data identification code in a signed document, Applicant is directed to column 9, lines 19-34 of the Romney patent. The authenticator attaches the authenticator identification envelope which includes the authentication statement to the client signed document.

5. For at least the above reasons, the rejection is maintained.

### ***Response to Amendment***

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2134

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 1, 2, 4, 5, 6, 8-12, 14, 16, 17, 22-27, 29, 30, 32-36, 38, 40, 41, 46-50, 52-55, 57-59, 62, 63, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 6,085,322 to Romney, et al. (hereinafter Romney).

As to claims 1 and 25, Smithies teaches:

- a. Having the user access the web environment from a secure electronic system, said secure system having verified the identity of the user (Smithies, column 12, lines 28-54).
- b. Having the user sign the electronic document in said web environment, said signing being server-based (Smithies, column 12, lines

14-16 and column 41, line 39-column 42, line 52) and comprising the substeps of:

- i. Presenting the user with a web-based representation of the document (Smithies, column 42, lines 8-24).
  - ii. Presenting the user with legal information related to said signing and getting agreement from the user of said legal information (Smithies, column 34, lines 8-17).
  - iii. Upon agreement from the user of the legal information, applying said signature of the user on said document (Smithies, column 29, lines 46-53).
- c. Generating a process log (transcript object) of the signing of step b), said process log providing for reconstruction of step b) as executed by said user, and securely associating said process log with the document as signed (transcript object recreates the document and all actions during the signing procedure to the user for final approval of the signature and document) (Smithies, column 42, lines 32-52).
- i. Generating a secure process authentication code (checksum) uniquely representing said process log (transcript object) (Smithies, column 14, lines 22-39).

Smithies teaches a link between the document and the transcript object (Smithies, column 14, lines 34-39 and 58-62), but does not expressly mention

Art Unit: 2134

placing a code in the signed document. However, in an analogous art Romney teaches:

- ii. Embedding said process authentication code (authenticator identification envelope) in said document as signed, thereby securely associating said process log and document (Romney, column 9, lines 19-33).
- d. Making the document as signed available to the user (Romney, column 11, lines 36-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the digital signature scheme of Smithies with the attachment of the authenticator identification envelope to the signed document of Romney in order to authenticate electronic documents as suggested by Romney (Romney, column 1, lines 10-12).

As to claims 2 and 30, Smithies as modified teaches retrieving said document from a document storing location (Smithies, column 20, lines 55-63 and column 42, lines 8-30).

As to claims 4 and 32, Smithies as modified teaches transforming said document from a non-web format to a web-format (Smithies, column 20, line 55-column 21, line 7).

As to claims 5 and 26, Smithies as modified teaches said legal information comprises information about legal implications of the signing of the document (Smithies, column 34, lines 8-18).

As to claim 6 and 27, Smithies as modified teaches said legal information comprises legal disclosures related to said document (Smithies, column 13, lines 14-23 and column 22, lines 2-7).

As to claims 8 and 29, Smithies as modified teaches presenting said legal information in a series of dialog boxes (Smithies, column 34, lines 5-33 and figures 4a-g).

As to claims 9 and 33, Smithies as modified teaches associating user-specific information to said document (Smithies, column 12, lines 51-55 and column 33, lines 6-34).

As to claims 10 and 34, Smithies as modified teaches said user-specific information is included in a special signature file defining the signature of the user (Smithies, column 13, lines 42-46).



Art Unit: 2134

As to claims 11 and 35, Smithies as modified teaches comprises associating a digital certificate (transcript object) (Smithies, column 12, lines 32-38 and column 37, lines 25-33) and a private key to the document (Smithies, column 8, lines 38-44).

As to claims 12 and 36, Smithies as modified teaches obtaining said user-specific information from the secure electronic system (Smithies, column 33, lines 6-34 and column 12, lines 51-54).

As to claims 14 and 38, Smithies as modified teaches storing said process log (transcript object) in a log database (Smithies, column 14, line 48-column 15, line 11).

As to claims 16 and 40, Smithies as modified teaches said secure process authentication code is a hash of said process log (Smithies, column 14, lines 5-21).

As to claims 17, 41 and 63, Smithies as modified teaches providing an audit trail of the signing of step b) in the document as signed (Smithies, column 28, line 46-column 29, line 67).

As to claims 22 and 46, Smithies as modified teaches transmitting a copy of the document as signed to the user (Romney, column 11, lines 34-49).

As to claims 23 and 47, Smithies teaches enabling the user to download the document as signed (Romney, column 11, lines 34-49).

As to claims 24 and 48, Smithies teaches making the document as signed available to at least one additional party concerned by said electronic document (Romney, column 11, lines 34-49).

As to claim 49, Smithies as modified teaches:

- a. Accessing means for accessing said web environment from a secure electronic system (Smithies, column 12, lines 28-54).
- b. A document-rendering module for presenting the user with a web-based representation of said document (Smithies, column 42, lines 8-24).
- c. A legal disclosure module for presenting the user, in said web environment, with legal information related to electronically signing said document and obtaining agreement from the user of said legal information (Smithies, column 34, lines 8-17).
- d. A document approval module for providing the signature of the user to the document upon agreement from the user of the legal information, thereby signing said document (Smithies, column 29, lines 46-53).
- e. A process log module for generating a process log of the signing of the document and securely associating said process log with the document as signed (transcript object recreates the document and all actions during

the signing procedure to the user for final approval of the signature and document) (Smithies, column 42, lines 32-52).

- f. Presenting the user with said web-based representation of the document (Smithies, column 42, lines 8-24).
- g. Presenting the user with said legal information (Smithies, column 34, lines 8-17).
- h. Obtaining agreement from the user of said legal information and of said signing of the document (Smithies, column 29, lines 46-53).
- i. A document distribution module for making the document as signed available to the user, wherein said accessing means and said document-rendering, legal disclosure, document approval, process log and document distribution modules are server-based (Romney, column 11, lines 34-49).

As to claim 50, Smithies as modified teaches said document-rendering module comprises retrieving means for retrieving said document from a document storing location (Smithies, column 20, lines 55-63 and column 42, lines 8-30).

As to claim 52, Smithies as modified teaches transforming means for transforming said document from a non-web format to a web-format (Smithies, column 20, line 55-column 21, line 7).

As to claim 53, Smithies as modified teaches said legal information comprises information about legal implications of the signing of the document (Smithies, column 34, lines 8-18).

As to claim 54, Smithies as modified teaches said legal information comprises legal disclosures related to said document (Smithies, column 13, lines 14-23 and column 22, lines 2-7).

As to claim 55, Smithies as modified teaches said legal disclosure module comprises displaying means for displaying (Smithies, column 19, lines 39-43) said legal information (Smithies, column 24, lines 63-67) in a web-based medium (Smithies, column 12, lines 14-16).

As to claim 57, Smithies as modified teaches said web-based medium includes a plurality of dialogue boxes (Smithies, column 34, lines 5-33 and figures 4a-g).

As to claim 58, Smithies as modified teaches:

- a. A user binding module cooperating with the secure electronic system to obtain therefrom user-specific information (Smithies, column 12, lines 51-55 and column 33, lines 6-34).
- b. Generating a special signature file using said user-specific information (Smithies, column 13, lines 42-46).
- c. Providing said special signature file to the document approval module, said special signature file defining the signature of the user (Smithies, column 13, lines 42-46).

As to claim 59, Smithies as modified teaches said user-specific information comprises a digital certificate (transcript object) (Smithies, column 12, lines 32-38 and column 37, lines 25-33) and private key (Smithies, column 8, lines 38-44).

As to claim 62, Smithies as modified teaches means to generate a secure process authentication code comprise a hash module (Smithies, column 14, lines 22-39).

As to claim 67, Smithies teaches transmitting a copy of the document as signed to the user (column 21, lines 35-38).

As to claim 68, Smithies teaches provides a copy of the document as signed to at least one additional party concerned by said electronic document (column 40, lines 16-30).

10. Claim 3 and claim 31 and claim 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 6,085,322 to Romney, et al. (hereinafter Romney) as applied to claim 1 and claim 25 and claim 49 above, and further in view of US Patent No. 5,649,186 to Ferguson.

As to claims 3 and 31, Smithies as modified does not expressly mention the use of templates in the generation of documents. However, in an analogous art, Ferguson teaches generating said document from a template (Ferguson, column 2, lines 52-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic signing scheme of Smithies with the use of templates to generate documents of Ferguson in order to display them in a standardized way (HTML) as suggested by Ferguson (Ferguson, column 2, lines 52-60).

As to claim 51, Smithies as modified teaches a document customization module cooperating with the document-rendering module for generating said document from a template (Ferguson, column 2, lines 52-60).

11. Claim 7, claim 28 and claim 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 6,085,322 to Romney, et al. (hereinafter Romney) as applied to claim 1 and claim 25 and claim 55 above, and further in view of US Patent No. 6,151,624 to Teare et al. (hereinafter Teare).

As to claims 7 and 28, Smithies as modified teaches displaying the legal information concerning the signing of a document (Smithies, column 34, lines 8-18), but does not expressly state that the legal information is displayed as a web page. However, in an analogous art, Teare teaches presenting said legal information in a series of web pages (Teare, column 16, lines 16-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the electronic signing scheme of Smithies with the presentation of the legal information associated with the signing as a web page of Teare so that the user can accept or decline the legal agreement over the internet as suggested by Teare (Teare, column 16, lines 16-27).

As to claim 56, Smithies as modified teaches said web-based medium includes a plurality of web pages (Teare, column 16, lines 16-27).

12. Claims 18-21 and claims 42-45 and claims 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 6,085,322 to Romney, et al. (hereinafter Romney) as applied to claim 17 and claim 41 and claim 49 respectively above, and further in view of US Patent No. 5,606,609 to Houser et al. (hereinafter Houser).

As to claims 18, 42 and 64, Smithies as modified does not expressly mention hashing a signed document to use as an authentication measure. However, in an analogous art, Houser teaches including a secure document authentication code uniquely representing said document as signed in said audit trail (Houser, column 4, lines 20-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the digital signature scheme of Smithies as modified with the hashing of a signed document of Houser in order to ensure the validity of a signed document as suggested by Houser (Houser, column 4, lines 27-34).

As to claims 19 and 43, Smithies as modified teaches storing said secure document authentication code in a database (Smithies, column 14, line 48-column 15, line 11).



As to claims 20, 44 and 65, Smithies as modified teaches generating a hash of said document as signed defining the secure document authentication code Houser, column 4, lines 20-34).

As to claims 21, 45 and 66, Smithies as modified teaches embedding a secure document authentication code (hash of signed document) uniquely representing the document as signed inside said document (Houser, column 4, lines 20-34).

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2134


Any inquiry concerning this communication or earlier communications from the examiner should be directed to William S. Powers whose telephone number is 751 272 8573. The examiner can normally be reached on m-f 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
8/6/2007

William S. Powers  
Examiner  
Art Unit 2134

  
KAMBIZ ZAND  
SUPERVISORY PATENT EXAMINER